



Attorney Docket No. YO998-522

AF123

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): L.D. Comerford et al.  
Docket No.: YO998-522  
Serial No.: 09/460,913  
Filing Date: December 14, 1999  
Group: 2654  
Examiner: Abul K. Azad

I hereby certify that this paper is being deposited on this date with the U.S. Postal Service as first class mail addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signature:

*David L. Culpis*

Date: September 28, 2004

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Technology Center 2600

Title: Methods and Apparatus for Contingent  
Transfer and Execution of Spoken  
Language Interfaces

TRANSMITTAL OF REPLY BRIEF

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Submitted herewith is the following document relating to the above-identified patent application:

- (1) Reply Brief (original and two copies).

It is believed that there is no additional fee due in conjunction with the response. In the event of any non-payment or improper payment of a required fee, the Commissioner is hereby authorized to charge or to credit **International Business Machines Corporation Deposit Account No. 50-0510** as required to correct the error. Duplicate copies of the Reply Brief are enclosed.

Respectfully submitted,

*Wayne L. Ellenbogen*

Date: September 28, 2004

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Signature: Lisa L. Chulpi Date: September 28, 2004

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**REPLY BRIEF**

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Sir:

Applicants (hereinafter referred to as "Appellants") submit this Reply Brief under 37 C.F.R. §1.193(b)(1) in response to the Examiner's Answer mailed on July 28, 2004 relating to the Supplemental Appeal Brief filed by Appellants on April 26, 2004 appealing the final rejection of claims 1-19 of the above-identified application.

**ARGUMENT**

The Examiner, in his Answer to Appellants' Supplemental Appeal Brief, has withdrawn the rejections to claims 1-5 and 9-12, and therefore only claims 6-8 and 13-19 remain rejected for the purposes of this Appeal. With regard to these claims, the Examiner reasserts his arguments that claims 6, 7, 13 and 19 are unpatentable under 35 U.S.C. §102(e), and claims 8 and 14-18 are unpatentable under 35 U.S.C. §103(a). These grounds of rejection were addressed in Appellants'

Supplemental Appeal Brief. Appellants therefore re-allege herein and incorporate by reference the arguments presented in their Supplemental Appeal Brief in their entirety.

In addition, the Examiner's Answer appears to present further arguments in support of such rejections. Appellants will address below some of these further arguments offered in the Examiner's Answer and further point out the deficiencies in the Mozer reference, and therefore the cited combinations that include Mozer. Appellants respectfully disagree with the assertions presented by the Examiner in the Answer, for at least the reasons identified below, as well as for those reasons previously set forth in the Supplemental Appeal Brief.

On page 13, paragraph 2 of the Answer, the Examiner, with regard to independent claims 6 and 19 disagrees with Appellants' assertion that Mozer fails to teach automatically providing a new spoken language interface for the user. The Examiner maintains his contention that Mozer discloses automatically providing a new spoken language interface for the user "because Mozer teaches the recognition system can select a new set of words and associated weights for recognizing a new utterance" (Examiner's Answer; page 14, paragraph 2). Appellants respectfully disagree with this contention.

While Mozer, on page 3, paragraph 0033, discloses that "pattern recognition programming system 112 receives the recognition result and selects a new set of words and associated weight set based on this result," Appellants maintain their assertion that the new set of words and associated weight set taught by Mozer is not analogous to the spoken language interface data set recited in claims 6 and 19. As stated in Appellants' Supplemental Appeal Brief, the present specification provides a clear construction of the term "spoken language interface data set," as the term is intended to be used in the subject claims. The specification, at least at page 3, beginning at line 3, explicitly defines a spoken language interface data set as including those sets of user interface files which play a role in structuring the interface. It is to be emphasized that the recognition and weight sets taught by Mozer are not configurable for use in structuring a spoken language interface itself, nor are they capable of defining parameters of operation of the speech recognition system. Consequently, Appellants assert that the recognition and weight sets are not analogous to the spoken language interface data set recited in the subject claims.

The Examiner contends that "it is noted that other features upon which applicant relies are not recited in the rejected claim(s)" (Examiner's Answer; page 14, last paragraph to page 15, first

paragraph). While Appellants acknowledge that limitations from the specification typically cannot be read into the claims, the claim elements must be read in view of the specification. In the present case, the language “spoken language interface data set” already appears in claims 6 and 19, and thus no attempt has been made to read an element into the subject claims. When the specification provides definitions for terms appearing in the claims, the specification can be used in interpreting such claim language (MPEP §2111.01; citing *In re Vogel*, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970)). Mozer fails to teach or suggest a spoken language interface data set defined in the manner set forth above. In this regard, Appellants assert that in rejecting claims 6 and 19, the Examiner inappropriately attempts to impute a much broader scope to the Mozer reference than what is specifically taught or suggested by the reference itself.

It is well-settled that “[a] patentee is his own lexicographer” (*Canaan Prod., Inc. v. Edward Don & Co.*, 388 F.2d 540, 544, 156 USPQ 295, 298 (7th Cir. 1968)), and that “[a] patentee may define his own terms, regardless of common or technical meaning, and fairness to the patentee requires the court to accept his definition of words, phrases, and terms” (*International Cork Co. v. New Process Cork Co.*, 6 F.2d 420, 422 (2d Cir. 1925) (emphasis added)). The Federal Circuit has reiterated this doctrine, stating that: “It is a well-established axiom in patent law that a patentee is free to be his or her own lexicographer, . . . and thus may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings. For this reason, an analysis of the specification and prosecution history is important to proper claim construction.” *Hormone Research Foundation, Inc. v. Genetech, Inc.*, 904 F.2d 1558, 1563, 15 USPQ2d 1039, 1043 (Fed. Cir. 1990) (emphasis added).

Even assuming, *arguendo*, that the spoken language interface data set recited in claims 6 and 19 can be analogized to the recognition set and weight set disclosed in Mozer, Mozer fails to teach or suggest that the spoken language interface data set is automatically requested from an external network with which the user interacts, or that the user interfaces with the external network, as required by the subject claims. In contrast to the invention set forth in claims 6 and 19, Mozer discloses obtaining a recognition set and weight set from an external medium (Mozer; page 3, paragraph 0033), which Mozer states may be compact disks (Mozer; page 4, paragraph 0035). However, while Mozer may disclose that “other information, independent from the recognition set and weight set information” may be transferred from the external medium (Mozer; page 3, paragraph

0033), Mozer fails to teach or suggest that the user interacts, meaning “to act on each other” (*The American Heritage Dictionary of the English Language*, Fourth Edition, Houghton Mifflin Company, 2000), with the external medium in any way.

Claims 6 and 19 further require a discovery process, whereby a spoken language interface data set is requested “from the external network upon discovery of the external network.” Appellants submit that Mozer fails to disclose such a discovery methodology. Rather, in the apparatus disclosed in Mozer it is assumed that the external medium is already connected to the base unit (Mozer; page 2, paragraph 0023), thus obviating the need for discovery.

For at least the above reasons, Appellants believe that Mozer fails to disclose all of the limitations set forth in claims 6 and 19.

With regard to claim 13, the Examiner contends that “Mozer teaches ‘pattern recognition system 112 receives the recognition result and selects a new set of words and associated weight set based on this result,’” and that the set of words is the parameter which is changed (Examiner’s Answer; page 15, last paragraph). Appellants respectfully disagree with this contention and assert that the new set of words and associated weight set are not analogous to “a predetermined parameter of the device,” as recited in claim 13. The predetermined parameter of the device which may be modified is defined by the specification as affecting an operating function of the device. Without loss of generality, the specification provides an illustration of a modifiable parameter of the device, by stating:

The user may, if vocabularies and prompts are supplied, address the dialog manager itself, changing initialization parameters such as the speed of synthesized speech by means of a spoken command, such as “speak slower.” This further supports the illusion of understanding on the part of the dialog manager. (Specification, page 31, lines 18-21)

Claim 13 is further distinguishable from Mozer in that Mozer fails to disclose prompting the user for information in order to modify one or more parameters and/or an application running on the device, as required by claim 13. Rather, Mozer discloses that the “pattern recognition programming system 112 receives the recognition result and selects a new set of words and associated weight set based on this result” (Mozer; page 3, paragraph 0033; emphasis added), without prompting the user for information.

For at least the above reasons, Appellants believe that Mozer fails to disclose all of the limitations set forth in claim 13.

With regard to independent claim 16, in their Supplemental Appeal Brief, Appellants argued with regard to claim 16 that the Examiner has failed to establish a *prima facie* case of obviousness, as set forth in MPEP §2143. Specifically, Appellants maintain their assertion that the three necessary criteria for establishing a *prima facie* case of obviousness have not been met.

First, the Examiner contends that the suggestion or motivation to combine the Mozer and Freadman references “is the knowledge generally available to one of ordinary skill in the art, because it would have been obvious . . . to include Mozer’s concept of speech recognition and a digital signal processor interfacing speech input in a consumer electronic products [sic] because it would have coordinated control of voice input, commanding, and audio output to Freadman’s personal digital assistant” (Examiner’s Answer; page 17, last paragraph). Appellants respectfully disagree that this statement provides the necessary motivation to combine reference teachings.

It is well-settled law that “teachings of references can be combined *only* if there is some suggestion or incentive to do so.” *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (emphasis in original). Moreover, in order to avoid the improper use of a hindsight-based obviousness analysis, particular findings must be made as to why one skilled in the relevant art, having no knowledge of the claimed invention, would have selected the components disclosed by Mozer and Freadman in the manner claimed (*See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). The Examiner’s conclusory statements that it would have been obvious to include Mozer’s concept of speech recognition and a digital signal processor interfacing speech input in a consumer electronic product “because it would have coordinated control of voice input, commanding, and audio output to Freadman’s personal digital assistant” (Examiner’s Answer; page 17, last paragraph) does not adequately address the issue of motivation to combine references. Simply stating that a proposed combination of references “could” be performed or “would have coordinated control” does not provide the necessary motivation for such combination. “It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[use] that which the inventor taught against its teacher.’” *In re Sang-Su Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002) (quoting *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

As Appellants stated in their Supplemental Appeal Brief, one skilled in the art would not look to a plug-in sound accessory for a portable computer, as taught by Freadman, to find inspiration for improving or otherwise modifying a speech recognition system for adding speech recognition functionality to consumer electronic products, as taught by Mozer, or vice versa. Accordingly, Appellants respectfully submit that motivation to combine the Mozer and Freadman references has not been properly established.

Second, the Examiner contends that the “new recognition set” taught by Mozer at page 3, paragraph 0030 is analogous to the spoken language interface recited in claim 16 (Examiner’s Answer; page 19, paragraph 2). Appellants respectfully disagree with the Examiner’s contentions and assert that, even assuming, *arguendo*, that the Mozer and Freadman references may be combined, the combination of Mozer and Freadman fails to disclose all of the elements set forth in claim 16.

As previously stated in connection with claims 6 and 19, the specification, at least at page 3, beginning at line 3, explicitly defines a spoken language interface data set as including those sets of user interface files which play a role in structuring the interface. It is to be emphasized that the recognition and weight sets taught by Mozer are not configurable for use in structuring a spoken language interface itself, nor are they capable of defining parameters of operation of the speech recognition system. Consequently, Appellants assert that the recognition and weight sets are not analogous to the spoken language interface data set recited in the subject claims.

Mozer also fails to teach or suggest that the spoken language interface data set is requested from an external network with which the user interacts, or that the user interfaces with the external network, as required by claim 16. In contrast to the invention set forth in claim 16, Mozer discloses obtaining a recognition set and weight set from an external medium (Mozer; page 3, paragraph 0033), as previously stated. However, while Mozer may disclose that “other information, independent from the recognition set and weight set information” may be transferred from the external medium (Mozer; page 3, paragraph 0033), Mozer fails to teach or suggest that the user interacts, meaning “to act on each other” (*The American Heritage Dictionary of the English Language*, Fourth Edition, Houghton Mifflin Company, 2000), with the external medium.

Claim 16, like claims 6 and 19, further requires a discovery process, whereby the portable spoken language interface device is operative to “request a spoken language interface data set from

the external network upon discovery of the external network.” Appellants submit that Mozer fails to disclose such a discovery process. In contrast to the claimed invention, in Mozer it is assumed that the external medium (104) is already connected to the base unit (102) (Mozer; page 2, paragraph 0023), thus obviating the need for discovery.

Mozer further fails to disclose a portable spoken language interface device. Rather, Mozer explicitly teaches that the speech recognition device is “placed in the base unit of an electronic apparatus” (Mozer; page 2, paragraph 0012; emphasis added). The term “base unit” as disclosed in Mozer implies that the device is not intended for portable operation.

For at least the above reasons, Appellants believe that Mozer fails to disclose all of the limitations set forth in claim 16. Furthermore, Freadman fails to supplement the deficiencies of Mozer.

With regard to claim 18, the Examiner, on page 19, paragraph 4 of his Answer, contends that Appellants’ arguments “fail to comply with 37 C.F.R. §1.111(b) because they amount to a general allegation that the claims define a patentable invention without pointing out how the language of the claims patentably distinguishes them from the references.” Appellants respectfully disagree with the Examiner’s contention and assert that Appellants have stated, in their Supplemental Appeal Brief, that the Abella reference “fails to teach or suggest a dialog manager having the functionality as defined by the present specification” (Supplemental Appeal Brief; page 20, first paragraph). Furthermore, Appellants have discussed patentably distinguishable features of the dialog manager, as defined by the present specification, in connection with Issue 1, the arguments of which were incorporated by reference in Issue 5 (Supplemental Appeal Brief; page 19, paragraph 6). Specifically, Appellants stated, on page 7, paragraph 2 of their Supplemental Appeal Brief, that the dialog manager “is explicitly defined in the present specification to include ‘an interpreter component 1010, an engine manager 1020 and a serial port communications interface 1030’ (present specification; page 7, lines 19-21).” These functionalities of the dialog manager are not disclosed in the prior art of record. As previously asserted, when the specification provides definitions for terms appearing in the claims, the specification can be used in interpreting such claim language (MPEP §2111.01; citing *In re Vogel*, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970)).

Abella fails to teach or suggest that the dialogue manager 30, which is “generally implemented in software run by processor 18 and stored in memory 16” (Abella; column 7, lines 51-

53) implements the dialog manager functionality recited in claim 18. Specifically, Abella discloses that the dialogue manager includes “a grammar, frames, and interpretation trees” (Abella; column 8, lines 53-54), and is essentially only capable of performing a single application, namely, facilitating conversation with a user. The dialog process is described in Abella, beginning at column 7, line 53, to column 8, line 33. Unlike the dialogue manager disclosed in Abella, the dialog manager recited in claim 18 is configurable for interfacing with multiple applications, in accordance with its engine manager component discussed above. In this regard, Appellants assert that the Examiner’s characterization of Abella attempts to impute a much broader scope to the Abella reference than what is specifically taught or suggested by the reference itself.

For at least the reasons identified above and in their previously-filed Supplemental Appeal Brief, Appellants again respectfully request withdrawal of the rejections of claims 1-19 and allowance of said claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wayne L. Ellenbogen", with a long horizontal flourish extending to the right.

Date: September 28, 2004

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